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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,386	11/05/2003	Makoto Suzuki	Q78247	6365
23373	7590	05/25/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			SCHILLING, RICHARD L	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/701,386

Applicant(s)

SUZUKI ET AL.

Examiner

Richard L. Schilling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4,8 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,4,8 and 12 is/are allowed.
- 6) ☒ Claim(s) 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Yamashita et al. and European Patent Publication 277509. The rationale of this rejection is set forth in paragraph 5 of the first Office action filed December 13, 2004. Instant claim 13 now requires the aromatic compounds to be in the silver halide material prior to processing instead of contacting the silver halide material with the aromatic compound as in original claim 13. Yamashita et al. disclose silver halide materials containing both silver halide sensitized with multiple layers of sensitizing dyes and the aromatic stain preventing compounds of the European patent publication.

2. Claims 15 and 16 are rejected under 35 U.S.C. 102() as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over European Patent Publication 277509. The European patent publication (see particularly page 4, lines 25-55; pages 8-13) discloses residual color stain reducing agents including compounds with two aromatic rings joined by linkages containing double bonds. Stain reducing compound III-21 of the European patent publication contains two aromatic groups joined by linkages with double bonds and carboxy substituent as required in new claim 15. Compound III-40 has 6 aromatic rings as required by new claim 16. If the European patent publication does not

anticipate claims 15 and 16, then it would at least be obvious to one skilled in the art to use specifically disclosed compounds III-21 or 40 as the called for color stain reducing agents in the European patent publication.

3. Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Parton et al. and Morgati et al. for the same reasons as set forth in paragraph 6 of the first Office action. Parton et al. discloses silver halide elements sensitized with multiple layers of sensitizing dyes and residual color reducing compounds in their silver halide emulsions prior to processing including the compounds of Morigati et al. incorporated by reference.

4. Claims 15 and 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morigati et al. Morigati et al. (see particularly column 3, line 4 - column 4, line 15; column 41, lines 38-50) disclose silver halide photographic materials with stain reducing agents including two aromatic rings joined by groups with double bonds. In regard to new claim 15, stain reducing compound III-63 contains a carboxy substituent. In regard to new claim 16, compounds III-40 and 58 have 5 aromatic rings.

5. Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamashita et al. or Parton et al. both in view

of Vargas et al. and Merkel et al. for the same reasons as set forth in paragraph 9 of the first Office action. Using the anti-stain reducing agents of Merkel et al. or Vargas et al. in the multiple layer dye sensitized elements of Yamashita et al. or Parton et al. or using the multiple dye sensitizing techniques of Yamashita et al. or Parton et al. in the dye sensitized elements of Vargas et al. or Merkel et al. fully meets the requirements of instant claim 13 of unprocessed silver halide materials with stain reducing agents and multiple layer dye sensitized silver halide grains.

6. Claims 15 and 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ikegawa et al. or Singer et al. Ikegawa et al. (see particularly column 1, lines 45-65; column 23, lines 25-62) disclose silver halide materials with residual sensitizing dye reducing compounds containing two aromatic groups joined with a group containing double bonds. Compounds 3, 6, 8-10, 14 and 18 contain sulfo substituents as required by instant claim 15. Compounds 5, 6, 9, 14, 15 and 18 have 5 aromatic rings as required by instant claim 16. Singer (see particularly column 2, lines 24-50) disclose silver halide materials with residual color reducing color developing agent scavengers comprising aromatic rings joined together by groups containing double bonds.

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Compound S-11 is substituted by sulfo as required by new claim 15. Compounds S-5 and 10 have 5 aromatic groups as required by new claim 16. If Ikegawa et al. or Singer et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use the compounds with sulfo groups or 5 aromatic rings as the called for residual sensitizing dye reducing compounds of Ikegawa et al. and to use compounds S-5, 10 or 11 of Singer et al. as the called for color reducing scavengers of Singer et al.

7. Gibson et al. (column 3, lines 10-55; compounds I-23, 24, 28, 32, 37, 38) is cited of interest in the art as disclosing compounds that reduce unwanted color having two aromatic groups joined by groups with double bonds and having 5 or more aromatic rings.

8. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL

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ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

May 24, 2005

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 1100-1752

